

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 1

Filed by: Linda R. Poteate
Administrative Patent Judge
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
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Filed: January 23, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JAY M. SHORT

Junior Party
U.S. Patent 6,479,258

v.

JUHA PUNNONEN, WILLEM P.C. STEMMER,
ROBERT G. WHALEN and RUSSELL HOWARD

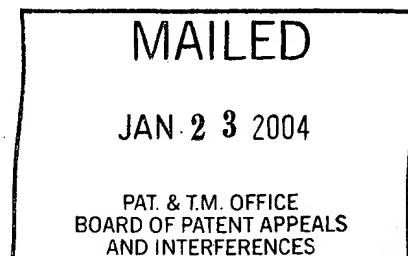
Senior Party
U.S. Application 09/724,869

Patent Interference No. 105,188

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. §135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.



Part B. Judge designated to handle the interference

Administrative Patent Judge Linda R. Poteate has been designated to handle the interference. 37 CFR § 1.601(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to discuss how next to proceed

A telephone call to set dates for taking action in the interference is scheduled for **1:00 p.m. on March 17, 2004** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See ¶ 10 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

The parties were also invited to consider participation in a voluntary electronic filing pilot project. A sample order setting procedures for electronic transmittal of papers is attached (see <http://www.uspto.gov/web/offices/dcom/bpai/its.htm>, University of New Mexico v. Fordham University, Interference No. 104,671, Paper 21).

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Jay M. Short, Rancho Santa Fe, CA

Patent: U.S. Patent 6,479,258,
issued November 12, 2002,
based on U.S. application 09/495,052,
filed January 31, 2000

Title: Non-Stochastic Generation of Genetic Vaccines

Assignee: Diversa Corporation

Accorded Benefit: none

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Juha Punnonen, Palo Alto, CA
Willem P.C. Stemmer, Los Gatos, CA
Robert G. Whalen, Paris, France
Russell Howard, Los Altos Hills, CA

Application: U.S. application 09/724,869,
filed November 28, 2000

Title: Optimization of Immunomodulatory Properties of Genetic
Vaccines

Assignee: Maxygen, Inc.

Accorded Benefit: U.S. application 09/248,716,
filed February 10, 1999

U.S. application 60/074,294,
filed February 11, 1998

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count

A method for obtaining an immunomodulatory polynucleotide that has an optimized modulatory effect on an immune response as compared to the response prior to optimization, or encodes a polypeptide that has an optimized modulatory effect on an immune response as compared to the response prior to optimization, the method comprising:

a) creating a library of recombinant polynucleotides; and

b) screening the library to identify an optimized recombinant polynucleotide that has, or encodes a polypeptide that has, a modulatory effect on an immune response induced by a vector;

wherein the optimized recombinant polynucleotide or the polypeptide encoded by the recombinant polynucleotide exhibits an enhanced ability to modulate an immune response compared to a polynucleotide from which the library was created;

wherein said optimized modulatory effect on an immune response is induced by a genetic vaccine vector, wherein the optimized recombinant polynucleotide encodes a co-stimulator selected from B7-1 (CD80) or B7-2 (CD86) and the screening step involves selecting variants with altered activity through CD28 or CTLA-4, and whereby optimization is achieved by recursive sequence recombination.

The claims of the parties are:

Short	1-86
Punnonen	47

The claims of the parties which correspond to the Count are:

Short	1-86
Punnonen	47

The claims of the parties which do not correspond to the Count, and therefore are not involved in the interference, are:

None

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See
¶ 3.5 of the STANDING ORDER.

Paper ____¹

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Linda R. Poteate)

JAY M. SHORT

Junior Party
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U.S. Application 09/724,869

Patent Interference No. 105,188

TITLE OF PAPER

¹ Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

- ¶ 4: date for identifying lead and backup counsel.
- ¶ 5: date for identifying any real party in interest.
- ¶ 6: date for requesting copies of involved and benefit applications and patents.
- ¶ 7: date for accomplishing certain discovery.
- ¶ 8: date for filing clean copy of claims
- ¶ 9: date for filing clean copy of claims with drawings or claims containing a means plus function limitation.
- ¶ 10: date for filing list of proposed preliminary motions.
- ¶ 13.10.2: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
- ¶ 14.1.1: date for objecting to admissibility of evidence.
- ¶ 14.2: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
- ¶ 14.3: dates when cross-examination can take place.
- ¶ 15.2: dates for taking action with respect to settlement discussions.

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 105,188

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge


LINDA R. POTEATE
Administrative Patent Judge

Date: January 20, 2004
Arlington, VA

Enc: Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference.

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

Copy of PTO-850

Copy of claims of application 09/724,869

Copy of U.S. Patent 6,479,258

cc (via overnight delivery):

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